

PATENT
App. Ser. No.: 10/600,390
Atty. Dkt. No. ROC920030238US1
PS Ref. No.: IBM/K30238

IN THE DRAWINGS:

The attached sheet of drawings includes changes to Figure 3A.

Attachments: **Replacement Sheet**
 Annotated Sheet Showing Changes

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REMARKS

This is intended as a full and complete response to the Office Action dated December 2, 2005, having a shortened statutory period for response set to expire on March 2, 2006. Please reconsider the claims pending in the application for reasons discussed below.

In the specification, the paragraph [0028] has been deleted.

In the drawings, Figure 3A has been changed to correct a typographical error.

Claims 1-35 are pending in the application. Claims 1-3, 6-9, and 11-19, 21-27, and 29-35 remain pending following entry of this response. Claims 1, 9, 15, 16, 19, 21, 22, 23, 24, 25 and 27 have been amended. Claims 4-5, 10, 20 and 28 have been canceled. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1-20, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nolan* (US Pat. No. 5,253,362 hereinafter *Nolan*) in view of *Sidana* (US Pat. No. 6,571,295 hereinafter *Sidana*). Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sidana* in view of *Katz*. Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criteria.

For example, with respect to independent claims 1, 19 and 25 the cited prior art references fail to teach at least an annotation browser "wherein the annotation browser

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is configured to access annotations in the annotation store independently of applications in which the annotation were created" as recited in these claims. As described in the specification of the present application, the claimed annotation browser may access, for example, annotations created for some portion of a document from within a word processing program, annotations created for some portion of a spreadsheet from within a spreadsheet program, or the like. In contrast, *Sidana* describes a browser that allows access to annotations only through the application in which they were created (the browser). See *Abstract*. According to *Sidana* "such customized documents may be presented to the user without modification of commercially available browser and/or server software." Therefore, Applicant submits claims 1, 19, and 25 and their dependents are allowable.

With respect to independent claim 9, the prior art references fail to teach "the annotation browser is configured to display annotations and links to associated data objects." While the Examiner argues that Figure 4 of *Sidana* discloses this element, Applicant respectfully submits that Figure 4 only shows a browser with a text box for inputting URLs, and an option to display annotations. Nowhere in Figure 4 are annotations and links to associated data objects displayed, only an option to display annotations is displayed. Therefore, Applicants submit claim 9 is allowable and request withdrawal of this rejection.

With respect to independent claims 27 and 33, the prior art references fail to teach querying both "annotations and annotated data." The Examiner argues that *Katz* anticipates claim 27 and original claim 33 by disclosing querying both "annotations and annotated data." The Examiner argues that *Katz* anticipates claims 27 and 33 by "allow[ing] for the simultaneous searching of annotations and annotated data objects (See column 7 31-36 note structured = object, unstructured = regular annotation)." Applicants respectfully submit, however that *Katz*, in fact, teaches away from the invention disclosed in independent claims 27 and 33, because it does not teach searching annotations and annotated data.

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Katz teaches searching only annotations, and not the annotated data itself. *Katz* states "the basic feature of the invention is that selected subdivisions of the text, such as sentences, paragraphs, sections, chapters, articles, columns, or the like, are annotated..." Col. 2, Lines 42-45. *Katz* states that "once the annotations have been stored, relevant textual subdivisions may be located by merely searching the annotations rather than the full text." Col. 3, Lines 25-27. *Katz* teaches searching only the annotations rather than the full text, thus *Katz* teaches away from searching annotations and annotated data. Therefore, claims 27 and 33 would not be obvious in light of *Katz* because there would be no motivation to combine the prior art references due to *Katz* teaching away from claims 27 and 33. Thus, Applicants submit claims 27 and 33, as well as those claims that depend therefrom, are allowable and request withdrawal of this rejection.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nolan* as applied to claim 19 above, in view of *Sidana* and in further view of *Katz* et. al. (US Pat. No. 5,309,359 hereinafter *Katz*). Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nolan* and *Sidana* as applied to claim 25 above, in further view of *Katz*. Applicants respectfully submit, however, for reasons discussed above, that the independent claims from which these claims depend are allowable. Accordingly, Applicants submit these claims are also allowable and request withdrawal of this rejection.

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Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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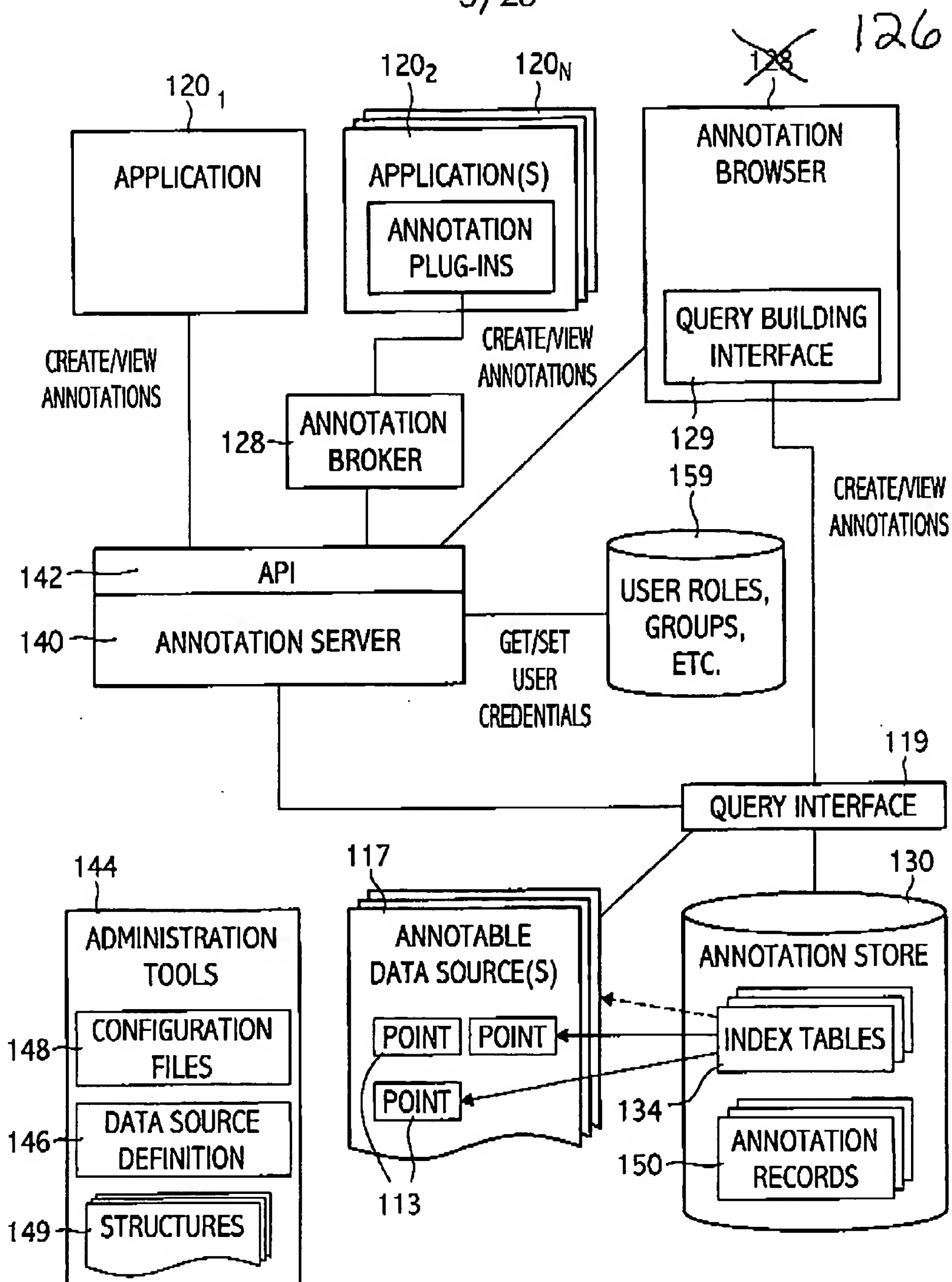


FIG. 3A